IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Makoto SANO et al.

Application No.: 09/215,555

Filed: December 18, 1998

Group Art Unit: 2176

Examiner: R. Singh

Docket No.: 102382

For: IMAGE PROCESSING APPARATUS, OUTPUT APPARATUS, IMAGE PROCESSING SYSTEM AND IMAGE PROCESSING METHOD

REPLY BRIEF

RECEIVED

JUN 1 6 2004

Technology Center 2100

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following comments are directed to the points and arguments raised in the Examiner's Answer dated April 14, 2004.

In the Related Appeals and Interferences section, on page 2 in the Examiner's Answer, the Examiner states that the brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on this decision. However, it is submitted that the Appeal Brief filed February 4, 2004 clearly states in section I.B that there are presently no appeals or interferences, known to Appellants, Appellants' representative or the Assignee that will have a bearing on the Board's decision in the pending appeal. Thus, it is respectfully submitted that the requirement for stating any related appeals and interferences has been satisfied by the statement made in the February 4, 2004 Appeal Brief.

I.   The Claims Are Not Obvious Over The Applied References

A.   Claims 1-6, 8-10 and 16 are not Obvious in View of Dennis et al.

The Examiner's first assertion, commencing on page 10 in the Examiner's Answer, is that "Dennis teaches the claimed features because page description language format can be converted to PDL format after a reconstructing means has been performed… although the data may be stored in PDL format initially, it does not prohibit the stored data from being converted back into PDF format after the reconstructing means for the purpose of being transmitted and printed." However, it is respectfully submitted that the Examiner has misconstrued Dennis et al. because the print data in Dennis et al. is already in the page description language (PDL) format stored within the host computer system. In fact, one of ordinary skill in the art would not convert the stored data back into PDL format after the reconstructing means, as asserted by the Examiner without destroying the reference. This is because Dennis et al. discloses that the PDL format describes the page in a single file called a metafile to create a set of bandable primitives for the entire page (col. 3, lines 45-61). However, the claimed invention discloses converting the data into a page description language form so as to process the data according to a type of print data. Accordingly, Dennis et al. fails to disclose or suggest a converting means for converting data reconstructed by the reconstructing means into page description language data that is in a page description language form, as recited in claims 1 and 16.

The Examiner's second assertion, commencing on page 10 in the Examiner's Answer, is that "in reference to Fig. 3, Dennis teaches transmitting a list of bandable primitives for the entire page. Objects that cross band boundaries are divided at the band boundaries. The objects are taken in the order they are created and overlapping objects are defined by previous objects." However, it is respectfully submitted that although Dennis et al. discloses

converting the "overlapping" objects, it never takes into consideration the band units with common data, as recited in the claimed invention. That is, Dennis et al. discloses that the metafile creates a bit-map data for the first object within the first horizontal band 102 and disregards any data that does not fall within the first band, creates another bit-map data for the second object with a second horizontal band 104, and so forth. However, the created bit-map data in Dennis et al. is generated from the stored metafile, and does not disclose or suggest reconstructing the band units with common data.

The Examiner's assertion that the portion discussed by the Appellants in the Appeal Brief is considered "prior art" in the Dennis et al. reference, is inconsistent. That is, the Examiner argues that Fig. 3 is prior art, but attempts to argue in the same paragraph that Fig. 3 teaches the claimed invention of the band units being reconstructed with common data. Thus, the Examiner's statement is found to be inconsistent and relied on a broad statement of obviousness without citing or showing any motivation that discloses or suggests the specific feature that the band units to be reconstructed have common data.

The Examiner's third assertion, commencing on page 11 in the Examiner's Answer, is that "different shapes and graphical objects require different reconstructing means". However, it is respectfully submitted that Dennis et al. fails to disclose or suggest that the band generator processes and distinguishes the print data according to a type of data. Although Dennis et al. discloses processing the metafile by converting all print objects into bandable primitives for the entire page, the claimed invention requires dividing modules (i.e., text, image and graphics) that determine and distinguish between the type of data to be divided (Fig. 6). In other words, Dennis et al. discloses processing the metafile and converting all print objects, including different shapes and graphical objects into bandable print images for the entire page, rather than processing and distinguishing the print data according to a type of data.

Thus, contrary to the assertions made by the Examiner, Dennis et al. does not disclose the aforementioned positively recited features of claims 1 and 16. Accordingly, claims 1-6, 8-10 and 16 are patentably distinct over the applied reference.

B. Claim 7 is not Obvious in View of Dennis et al. and Sugiyama et al.

As similarly discussed above, Sugiyama et al. also does not disclose or suggest the reconstructing means that processes and distinguishes print data according to a type of the print data, and decides whether the range units to be reconstructed have common data.

Accordingly, claim 7 is also patentable over the applied references.

C. Claims 11-15 are not Obvious in View of Dennis et al. and Ramchandran et al.

Regarding claim 13, the Examiner asserts that one of ordinary skill in the art would have combined Ramchandran's method of rasterizing print data with Dennis' method for receiving converting print data into PDL data since both Dennis and Ramchandran are related technology in image processing. However, the mere fact that both references are of related technology is sufficient, by itself, to establish *prima facie* obviousness. Accordingly, the mere assertion by the Examiner that one skilled in the art could have combined Dennis et al. and Ramchandran et al. because they are related technologies, is insufficient for an obviousness rejection under 35 U.S.C. §103(a). This motivation is not clear and particular, rather, it is a broad conclusory statement about the teaching of multiple references, and is not "evidence." Moreover, this motivation does not show the combination of these two references is desirable, which is required to serve as proper motivation to combine references. Thus, the Office Action has failed to make a *prima facie* case for obviousness of this claim, and should be allowed.

Accordingly, claims 11-15 are also patentable over the applied references.

It is respectfully submitted that the remaining points of arguments set forth in the Examiner's Answers were fully addressed and Appellants' Appeal Brief. For at least these reasons, set forth herein and in the Appeal Brief, it is respectfully submitted that claims 1-11 and 13-16 are in condition for allowance.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

David J. Cho
Registration No. 48,078

JAO:DJC/brc

Date: June 10, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE
AUTHORIZATION
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 15-0461